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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,314	08/31/2001	Martin W. Masters	2001P16282US	2179

7590 10/13/2004

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EXAMINER

LORENZO, JERRY A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/944,314
Filing Date: August 31, 2001
Appellant(s): MASTERS ET AL.

Joel Miller
17 Westwood Drive South
West Orange, NJ 07052
For Appellant

EXAMINER'S ANSWER

MAILED
OCT 13 2004
GROUP 1700

This is in response to the appeal brief filed July 27, 2004.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4) ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) ***Summary of Invention***

The summary of invention contained in the brief is deficient because the appellant states:

To prevent the hearing instrument from slipping out of the ear and to create an outward appearance that blends with the wearer's ear, the outer surface of a hearing instrument shell is given a ***textured, non-smooth finish*** (emphasis added).

This is deficient because the instant invention as set forth in claim 1, for example, does not limit "texture" to those textures having a "non-smooth finish." Rather, given the broadest possible reasonable interpretation, the term "texture" is inclusive of both smooth and non-smooth finishes.

(6) ***Issues***

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-3, 5-10 and 12-17 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The admitted prior art of the instant specification at page 1, lines 4-10.

3,567,871	WALTER	3-1971
5,581,627	BOWSER et al.	12-1996
4,803,853	HOERKENS	2-1989
6,097,825	YOEST et al.	8-2000
6,595,317	WIDMER et al.	7-2003

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art at page 1, lines 4-10. This rejection is set forth in a prior Office Action, mailed on May 18, 2004.

Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,567,871 to Walter. This rejection is set forth in a prior Office Action, mailed on May 18, 2004.

Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,581,627 to Bowser et al. This rejection is set forth in a prior Office Action, mailed on May 18, 2004.

Claims 1-3, 6, 8-10, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,803,853 to Hoerkens. This rejection is set forth in a prior Office Action, mailed on May 18, 2004.

Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,097,825 to Yoest et al. This rejection is set forth in a prior Office Action, mailed on May 18, 2004.

Claims 1-3, 5, 7-10, 12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,595,317 to Widmer et al. This rejection is set forth in a prior Office Action, mailed on May 18, 2004.

Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,595,317 to Widmer et al. in view of U.S. Patent No. 4,803,853 to Hoerkens. This rejection is set forth in a prior Office Action, mailed on May 18, 2004.

(11) Response to Argument

Both the appellant's arguments and the case itself revolve around one main issue:

The meaning of the term "texture."

From the outset, the appellants argue that the use of the term "texture" in the instant invention, as claimed, is inclusive of only those textures which are "non-smooth." The appellant points to the instant specification as well as an ancillary source to provide support for their definition. With regards to the specification, the appellant points to page 2, lines 8-13 as an example of the "texture" contemplated by the appellant, i.e., the texture of natural skin. The ancillary source cited by the appellant¹ in support of their meaning states that the actual characteristics of the texture employed may be quite varied and are a matter of design choice and suitability to the application.

¹ Mark's Standard Handbook for Mechanical Engineers, "Surface-Texture Designation, Production and Control," 9th ed. 1987, pp. 13-75 through 13-81.

The Examiner respectfully submits, however, that neither the instant specification nor the ancillary source provide a valid basis upon which to limit the term “texture” to those textures which are non-smooth. Firstly, the section of the specification cited by the appellant is in no way definitive and only gives a non-limiting example of a texture, i.e., a textured finish having the appearance of natural skin. Secondly, the ancillary source also fails to provide such an exclusive meaning of texture and, in fact, uses the term “smother texture” in reference to products having a surface texture produced by polishing.² Finally, the Examiner respectfully submits that the appellant also contemplates the term “texture” as including both “smooth” and “non-smooth” surfaces given the differentiation provided by applicant claims 2 and 3.³ Therefore, the Examiner respectfully submits that the meaning of the term “texture” is not limited to those textures which are non-smooth and is in fact inclusive of both “smooth” and “non-smooth” textures. In light of the above discussion, the Examiner now takes the opportunity to address the appellant’s remaining arguments drawn to the claim rejections.

I. The rejection of claims 1, 2, 8 and 9 under 35 U.S.C. 102(b) as being anticipated by the admitted prior art at page 1, lines 4-10.

The appellant argues that “. . . the ‘smooth or glossy finish’ and the ‘shiny surface’ described [in the specification at page 1, lines 4-10] are not textures as discussed and claimed by the applicants.” As such, the appellant argues that “construed in a manner consistent with the specification, . . . the claims are not anticipated . . . “ The Examiner respectfully submits, however, that the construction of the term “texture” as being inclusive of both “smooth” and “non-smooth” textures is consistent with the specification. In addition, the Examiner respectfully

² See, e.g., p. 13-81, Table 13.5.6 entitles “Surface-Roughness Ranges of Production Processes”.

³ Appellant claim 2 utilized the broader, generic term “texture,” while appellant claim 3 more specifically limits the term “texture” to those having “a non-smooth texture.”

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submits that this inclusive construction is also consistent with the claims as originally filed as well as the ancillary source cited by the appellant. As such, the Examiner respectfully submits that the rejection of claims 1, 2, 8 and 9 under 35 U.S.C. 102(b) as being anticipated by the admitted prior art at page 1, lines 4-10 is proper and should be affirmed.

II. The rejection of claims 1-3 and 8-10 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,567,871 to Walter.

The appellant argues that telephone handset of Walter does not concern a "hearing instrument" and no one skilled in the art would confuse a telephone with a hearing instrument.. While the Examiner respectfully submits that the instant invention is drawn towards a hearing aid as a specific embodiment of a "hearing instrument," the Examiner also respectfully submits that the phrase "hearing instrument" is generic to a telephone handset. During examination, the claims must be interpreted as broadly as their terms reasonably allow.⁴ In addition, though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.⁵ As such, the Examiner respectfully submits that the rejection of claims 1-3 and 8-10 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,567,871 to Walter is proper and should be affirmed.

⁴ *In re American Academy of Science Tech Center*, 70 USPQ2d 1827 (CA FC 2004).

⁵ *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d. 1865, 1868 (Fed. Cir. 2004). *See also, E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims in view of the specification' without unnecessarily importing limitations from the specification into the claims.")

III. The rejection of claims 1-3 and 8-10 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,581,627 to Bowser et al.

The appellant argues that headphones of Bowser et al. do not concern a "hearing instrument" and no one skilled in the art would confuse headphones with a hearing instrument.. While the Examiner respectfully submits that the instant invention is drawn towards a hearing aid as a specific embodiment of a "hearing instrument," the Examiner also respectfully submits that the phrase "hearing instrument" is generic to a telephone handset. Based upon the explanation provided by the Examiner in section II, above, the Examiner respectfully submits that the rejection of claims 1-3 and 8-10 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,581,627 to Bowser et al. is proper and should be affirmed.

IV. The rejection of claims 1-3, 6, 8-10, 13 and 16 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,803,853 to Hoerkens.

The appellant argues that the attachment of a mesh screen covering to a hearing aid, as taught by Hoerkens, does not constitute modification of a hearing instrument or shell surface because the Hoerkens reference provides no suggestion to impart a texture to a hearing instrument or hearing instrument shell. The Examiner respectfully disagrees and submits that the securing of a mesh screen to the hearing aid body of Hoerkens imparts a texture thereby modifying the surface. The fact that Hoerkens is silent as to the texturizing effect of the mesh screen is immaterial to the application of the reference in anticipation of the claims because the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art,

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relevant for all they contain.⁶ As such, the Examiner respectfully submits that the rejection of claims 1-3, 6, 8-10, 13 and 16 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,803,853 to Hoerkens is proper and should be affirmed.

V. The rejection of claims 1, 2, 8 and 9 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,097,825 to Yoest et al.

The appellant argues that Yoest et al. does not disclose, teach or suggest the concept of imparting a texture as described in the specification. The Examiner respectfully submits, however, that it is not what the specification requires, but what the claims, as written, require. Based upon the discussion of the meaning of the word "texture" above, the Examiner respectfully submits that Yoest et al. discloses a hearing aid with a surface formed of a sponge-like material, which would exhibit a texture. As such, the Examiner respectfully submits that the rejection of claims 1, 2, 8 and 9 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,097,825 to Yoest et al. is proper and should be affirmed.

VI. Claims 1-3, 5, 7-10, 12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,595,317 to Widmer et al.

The appellant argues that Widmer et al. is inapplicable in anticipation of the claims because even though the method of producing the hearing aid of Widmer et al. may include the inclusion of a rib pattern onto the outer surface of the hearing aid shell, Widmer et al. utilizes the ribs for structural integrity and not as a method of imparting texture to the surface. The appellant goes on to argue that "the ribs on the otherwise smooth-surfaced shell of Widmer et al. no more constitute a 'texture' than do speed bumps on an asphalt road surface." Inapposite analogies aside, the Examiner respectfully submits that the use of patents as references is not limited to

⁶ *In re Heck*, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275,

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what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.⁷ Furthermore, a reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.⁸

As set forth in the grounds of rejection, Widmer et al. et al. disclose a method of fabricating a hearing instrument comprising the steps of fabricating a multi-layered shell having an outer surface from a mold derived from the user's ear; applying a laser to the surface and imparting a non-smooth texture to at least a portion of the outer surface of the shell that includes a series of lines or ribs. As such, Widmer et al. anticipates each of claims 1-3, 5, 7-10, 12 and 14-17 and their limitations and the Examiner respectfully submits that the rejection thereof is proper and should be affirmed.

VII. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,595,317 to Widmer et al. in view of U.S. Patent No. 4,803,853 to Hoerkens

The appellant argues that the combination of the Widmer et al. and Hoerkens references is based upon motivation found only in the claims, i.e., the Examiner has utilized impermissible hindsight in construction of the combination. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based

277 (CCPA 1968)).

⁷ *Supra*, note 6.

upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the instant case, both Widmer et al. and Hoerkens are drawn the hearing instruments (hearing aids) which are formed in such a manner to provide a tight, custom and comfortable fit. Widmer et al., for example, teaches that the ribs or grooves provided in the outer shell surface allow for a tight fit and also ensure that air flow the ear drum is uninhibited (column 6, lines 36-56). Hoerkens discloses that the provision of the texture and radiating pleats/flutes, i.e., waveforms, formed in the surface of the hearing aid by the mesh screen enhances flexibility and stability of the hearing instrument when worn (column 1, lines 24-28). Thus, the motivation to combine the Widmer et al. and Hoerkens reference is based only upon knowledge which was within the level of ordinary skill in the art at the time the claimed inventions were made; that knowledge being that the provision of waveforms to the surface of the hearing aid shell can enhance comfort and security of the hearing aid when worn. Therefore, given the preliminary discussion as to the meaning of the word "texture" and the evidence supporting the proper motivation to combine, the Examiner respectfully submits that the rejection of claims 6 and 13 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,595,317 to Widmer et al. in view of U.S. Patent No. 4,803,853 to Hoerkens is proper and should be affirmed.

⁸ *State Contracting & Eng 'g Corp .v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir.2003)

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



J.A. Lorengo, Primary Examiner

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October 7, 2004

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